

REMARKS

In the Office Action mailed January 30, 2007 the Examiner noted that claims 1-27 were pending, that claims 19-24 and 26 have been withdrawn from consideration, allowed claims 8 and 17, objected to claims 27 and rejected all claims. Claims 1, 4, 6, 5, 18, 25, and 27 have been amended, and, thus, in view of the forgoing claims 1-27 remain pending for reconsideration which is requested. No new matter has been added. The Examiner's rejections and objections are traversed below.

In the Office Action the Examiner objected to claim 27. Claim 27 has been amended in consideration of the Examiner's comments. If additional concerns with the claims arise, the Examiner is invited to telephone to resolve the same. Suggestions by the Examiner are also welcome. Withdrawal of the objection is requested.

In the Office Action the Examiner rejected claim 15 under 35 U.S.C. section 112 paragraph 2 as indefinite. Claim 15 has been amended in consideration of the Examiner's comments and it is submitted it satisfies the requirements of the statute. Withdrawal of the rejection is requested.

On page 3 of the Office Action, the Examiner rejected claims 1, 4, 5, 25 and 27 under 35 U.S.C. § 102 as anticipated by Macromedia Flash. Page 4 of the Office Action rejects claims 2, 3 and 18 under 35 U.S.C. § 103 over Macromedia Flash and Buxton. Page 6 of the Office Action rejects claims 6, 7, 10, 12-14 and 16 under 35 U.S.C. § 103 over Macromedia Flash and Bernstein (and with respect to claim 10 and additionally with Official Notice). Page 8 rejects claims 9, 11, and 15 over Macromedia Flash, Bernstein, and Buxton (and with respect to claim 11 additionally with Official Notice).

First, the Examiner has not established a *prima facie* case of anticipation or obviousness. As confirmed by the Examiner, the Examiner created the Macromedia reference and particularly figures 2-4. It is submitted that the reference itself must provide the teachings used to reject the claims, not a non-public use by the Examiner, particularly such a use over three years after the present application was filed. Withdrawal of the rejection as based on an inadequate teaching by the Macromedia Flash reference is requested.

Further, the invention of claim 1 is designed to provide an efficient layer editor. In furtherance of this goal, the controls of the layer editor are activated in a very efficient manner as now recited in claim 1. Macromedia Flash does not teach or suggest a combination of a layer representation graphic having layer names with a pop-up menu control activatable for each layer activatable from within the layer representation and that allows the layer to be edited and where

the control for each layer is activatable by one of pressing a left mouse button while a cursor is over the layer representation and pressing a pen tip while the pen tip is over the layer representation as recited in claim 1. Withdrawal of the rejections based on Macromedia Flash are requested.

Claims 4, 6, 18, 25 and 27 recite a similar beneficial feature not found in Macromedia Flash.

Buxton and Bernstein add nothing to Macromedia Flash with respect to the combination of features discussed above.

In addition there is no motivation to combine Macromedia Flash with Buxton. The Examiner justifies the combination by asserting that incorporating Buxton into Macromedia Flash would be obvious because it would "provide a straight forward way to embed multiples commands into a single mark." It is clear that the Examiner is using hindsight in making the combination because embedding multiple commands behind a linear menu in the form of another linear menu as is the case for the dialog boxes of Macromedia Flash in the Examiner's created figures would also be a straight forward way to embed multiple commands. That is, the Examiners faulty "motivation" applies equally well to the subject matter of Macromedia Flash alone and, thus, is not sufficient motivation for a combination absent the Examiner's use of impermissible hindsight.

Likewise the Examiners justification for combining Bernstein with Macromedia Flash is based on impermissible hindsight and without sufficient motivation. Bernstein is directed to a note taking system, not to a layer editor. There is no discussion in Bernstein or in Macromedia Flash about why it would be helpful or otherwise beneficial to use a note taking system in a layer editor, particularly one such as the Examiner's created Macromedia Flash reference where a tool is apparently provided to allow the entry of a name. Why would someone want to add another tool when an effective one is provided? The Examiner's reasoning is based on an opinion of the Examiner ("particularly well-suited" "often times more recognizable to the user"). The Examiner's hindsight opinions are not sufficient motivation for the combination.

Withdrawal of the rejections over Macromedia Flash with Buxton or Bernstein is requested for this reason.

The Examiner has based the rejection of claims 10 and 11 on Macromedia with Official Notice (claim 10) or Macromedia Flash with Bernstein and Buxton and Official Notice (claim 11) asserting that the features in question are well known or common knowledge. The Office Action attempts to rely on well known evidence to allege obviousness of the invention itself. It is well settled that "[i]t is never appropriate to rely solely on 'common knowledge' in the art without

evidentiary support in the record, as the principal evidence upon which a rejection was based" citing *In re Zurko*, 258, F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001)" (see MPEP 2144.03). The Office Action reached an unsubstantiated, ambiguous conclusion by relying on impermissible hindsight and alleged well known evidence. It is submitted that the allegations that the features are well known is incorrect and the allegations are based on the Examiner's personal knowledge and not based on prior art. The Examiner is requested to support the allegation with prior art or an affidavit under as required 37 CFR § 1.107(b). Based on the reasons presented above showing the errors in the Office Action's rejection of the claims, Applicant also respectfully requests (i.e., Demands) that references teaching or suggesting the alleged well known Officially Noted evidence be cited along with an Examiner's Affidavit describing the knowledge of the Examiner specifically relied on by the Examiner be presented in the next Office Action in accordance with MPEP § 2144.03.

It is submitted that the claims satisfy the requirements of 35 U.S.C. 112. It is also submitted that claims 8 and 17 continue to be allowable. It is further submitted that the claims are not taught, disclosed or suggested by the prior art. The claims are therefore in a condition suitable for allowance. An early Notice of Allowance is requested.

If any further fees, other than and except for the issue fee, are necessary with respect to this paper, the U.S.P.T.O. is requested to obtain the same from deposit account number 19-3935.

Respectfully submitted,
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